

**Appl. No.** : 09/933,277  
**Filed** : August 20, 2001

### **REMARKS**

In the Office Action mailed on August 5, 2004, the Examiner rejected all of the pending claims on obviousness grounds over Dicker et al (US 2003/0105682), which is owned by the assignee of the present application. Applicants respectfully submit that the rejection is improper.

Dicker et al was filed after the present application, and is a continuation-in-part of application no. 09/850,263 (hereinafter "the earlier-filed application"), which was filed prior to the present application. Pursuant to M.P.E.P. 706.02(f)(1), the "102(e) date of a reference ... is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications ... *if the prior application(s) properly support the subject matter used to make the rejection*" (emphasis added). Thus, subject matter which is disclosed only in Dicker et al, and not in the earlier-filed application, cannot be "prior art" under 35 U.S.C. 102(e) to the present application. Stated differently, any new subject matter added when Dicker et al was filed is not entitled to the filing date of the earlier-filed application for prior art purposes, and therefore is not available to the Examiner in rejecting the claims of the present application.

In rejecting the claims of the present application, the Examiner relied on subject matter that is disclosed only in Dicker et al, and not in the earlier-filed application. For example, the Examiner relied on Dicker et al's disclosure of electronic wish lists, at paragraph 0141, in rejecting all of the claims. The earlier-filed application does not, however, disclose electronic wish lists. The rejection is therefore improper.

Applicants also submit that the pending claims are patentably distinct from the disclosure of Dicker et al. With respect to Claim 1, for example, Dicker et al does not disclose or suggest "a notification component which is responsive, to an online request from a first user for a catalog page which includes a description of a first item, by at least (a) determining whether the first item is on an electronic wish list of a user who is affiliated with the first user, and (b) when the first item is determined to be on an electronic wish list of a second user who is affiliated with the first user, supplementing the page with a notification that the first item is on the wish list of the second user." Thus, even if all of Dicker et al's disclosure could be treated as prior art, the rejection would still be improper.

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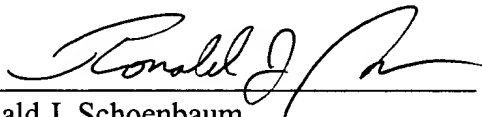
Finally, Applicants respectfully challenge and traverse the Examiner's use of Office Notice at page 3 of the Office Action. The Examiner's use of Office Notice as the basis for addressing a primary point of novelty in Claim 1 is improper. See MPEP 2144.03(A) ("It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection [is] based," citation omitted.) If the Examiner contends that the above-quoted limitations of Claim 1—or any other claim limitations—are known or are obvious, he is respectfully requested to identify specific prior art references that disclose or suggest each limitation.

If any issues remain in the present application, the Examiner is requested to call the undersigned representative at his direct dial number of 949-721-2950.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9-3-04

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